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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT

PAPER NUMBER

3641

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Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejections as necessitated by applicant's amendments.

### *Specification*

2. The amendment filed 9/12/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: means for viewing, means for carrying or holding and means for mounting.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must clarify the disclosure to **explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the means for viewing, means for carrying or holding and means for mounting recited in the claim elements and equivalents thereof.**

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed did not describe the means for viewing, means for carrying or holding or the means for mounting.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 8, 10-12, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Patent # 2,316,055) in view of Baker (US Patent # 6,886,446). Davey discloses a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material, a viewing window through the shield, handles associated with the shield that can be used for carrying the shield or holding the shield in front of at least a portion of a user's body or used as a forearm cuff and multiple firearms (not shown see page 2, lines 40-55) mounted to the shield and dischargeably operable when so mounted, wherein the firearm is

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mounted for discharge in a direction at an angle outwardly from the front face of the shield. The firearm is a pistol. The firearms are mounted so that they discharge in a plurality of directions including a direction substantially perpendicular to the front face of the shield. The shield can be employed and the firearm can be discharged with a single arm (presumably depending on the strength and dexterity of the user). Multiple firearms are mounted when shields are combined, it is inherent that the firearms can be discharged in any direction outward from the face of the shield including substantially perpendicular and substantially parallel to the shield. Although Davey does not expressly disclose the shield including a frame attached to the shield, Baker does. Baker teaches a hand-held ballistic shield including a frame attached to the shield that has the ability to mount a firearm. Davey and Baker are analogous art because they are from the same field of endeavor: ballistic shields. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the frame attached to the shield as suggested by Baker with the shield as disclosed by Davey. The suggestion/motivation for doing so would have been to obtain a hand-held ballistic shield that a user could easily position both the shield and firearm with one hand as suggested by Baker at column 6, lines 10-30). It is noted that the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

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A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Davey and Baker discloses the claimed invention except for the specific ballistic material selected from the claimed group or the material of the viewing window specifically selected from the claimed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific materials in making the shield, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and Davey discloses that such known materials are used in the construction of the shield. *In re Leshin*, 125 USPQ 416.

8. Claims 6, 7, 13, 14, and 16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey and Baker as applied to claim 1 above, and further in view of Resnick (US Patent # 6,272,781). Although neither Davey nor Baker expressly disclose a taser gun and battery and various sensors and communications devices mounted to the shield, Resnick does. Resnick teaches a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material; a handle associated with the shield and a taser gun mounted to the shield and dischargeably operable when so mounted. Although Resnick does not expressly mention the battery it is inherent that a power source (i.e. battery) would be present, since the taser gun would not operate without such a source. The shield further comprising a disabling sensor the disable

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the firing devices in response to a predetermined signal or a predetermined absence of a signal.

The shield comprising a plurality of communication accessories mounted to the shield selected from the claimed group, and further comprising a plurality of light sources. Davey, Baker and Resnick are analogous art because they are from the same field of endeavor: protective shields.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the taser gun as taught by Resnick with the shield taught by Davey as modified by Baker. The suggestion/motivation for doing so would have been to obtain a shield that provided the additional protections and advantages as suggested by Resnick.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey and Baker as applied to claim 1 above, and further in view of Lobdell (US Patent # 1,227,544). Although neither Davey nor Baker expressly disclose a mirror associated with the viewing window, Lobdell does. Lobdell teaches a mirror that can be mounted on a firearm to increase the field of vision. Lobdell, Baker and Davey are analogous art because they are from similar problem solving areas: protection while firing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the mirror as taught by Lobdell with the firearms and shield taught by Davey and modified by Baker. The suggestion/motivation for doing so would have been to obtain a shield that had an extended field of view.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey, Baker and Resnick. See ¶ above.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MICHELLE CLEMENT  
PRIMARY EXAMINER